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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR919980195US1 (8728-139)

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on February 22, 2006

Signature

Typed or printed name Frank V. DeRosa

Application Number

09/133,960

Filed

8/14/1998

First Named Inventor

R. Joshi

Art Unit

2611

Examiner

Tran, Hai V.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Signature

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Registration number if acting under 37 CFR 1.34 _____

February 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

 *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Joshi et al

Serial No: 09/133,960

Filed: August 14, 1998



Examiner: Hai V. Tran

Group Art Unit: 2611

Docket: YO998-195 (8728-139)

For:

**WIRELESS INFORMATION TRANSFER AND
INTERACTIVE TELEVISION SYSTEM**

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22312

Statement in Support of Pre-Appeal Brief Request for Review

This paper is being filed in support of Applicants' Pre-Appeal Brief Request for Review.

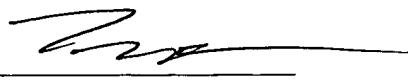
A Notice of Appeal has been filed herewith in response to the Final Office Action mailed on September 22, 2005. Applicants respectfully contend that the claim rejections set forth in the Final Office Action are clearly erroneous as a matter of fact and/or law.

CERTIFICATE OF MAILING 37 C.F.R. §1.8(a)

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Dated:

2/22/06


Frank V. DeRosa

Claim Rejections – 35 U.S.C. § 112

The basis for this rejection is an unsupported assertion that Applicants' specification does not disclose *first and second data processing units* as recited in claims 1 and 36. However, the Examiner ignores that an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using "such descriptive means as words, structures, figures, diagrams, etc., that fully set forth the claimed invention." *Lockwood v. American Airlines, Inc.* 107 F.3d 1565, 1572 (Fed. Cir. 1997). Indeed, it is well established that the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. See *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). "If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description is met." *In re Alton*, 76 F.3d at 1175 (see also *Vas-Cath*, 935 F.2d at 1563).

Here, it is abundantly clear that the communication units (104) illustrated in FIGs. 1 and 2 provide clear, express support for the claim terms first and second data processing units in the context of the claimed inventions. In fact, the elements 104/106a connected to television set (102) provide clear support for the claimed "*first communication system, operatively coupled to a television set, comprising a first RF transceiver unit and a first data processing unit ..*" In short, the Final Office Action fails to present a *prima facie* case of lack of written description under 112, first paragraph.

Claim Rejections – 35 U.S.C. § 103

The Final Office Action cites a multitude of references to support the claim rejections. In general, Applicants contend that the basis for the obviousness rejections are impermissible hindsight reasoning, where the obviousness rejections are based on selective citation to bits and pieces from multiple patents in an effort to derive the claimed inventions with no basis for combining the references. At this point, suffice it is to say that at the very least, the obviousness rejections of independent claims 1 and 36 are improper as a matter of law and fact.

Claim 1

With respect to claim 1, Applicants respectfully submit that the combination of Krisbergh and Lancelot does not disclose or suggest various features of claim 1, for example:

... a first communication system, operatively coupled to a television set, comprising a first RF transceiver unit and a first data processing unit for generating at least one information signal . . . a wireless signal transfer network for wirelessly transferring signals including the at least one information signal . . . a second communication system operatively coupled to the wireless transfer network, comprising a second RF transceiver unit and a second data processing unit for receiving and processing the at least one information signal and . . . generating at least one return information signal and providing the at least one return information signal to the wireless signal transfer network, *wherein the at least one information signal and the at least one return information signal are independently transmitted from a television signal.*

With respect to claim 1, Applicants respectfully submit that the combination of Krisbergh and Lancelot does not disclose or suggest the above features of claim 1. For example, the primary reference Krisbergh is directed to a system and method for providing access to the Internet through a cable television distribution system (see, Col. 1, lines 10-13). The Examiner acknowledges, at the very least, that Krisbergh does not disclose a return signal is independently transmitted from a TV signal (see, e.g., page 6 of the Final Action).

The Examiner relies on Lancelot in this regard. In particular, Examiner contends (without explanation) that Lancelot discloses (FIG. 2, Col. 4, lines 25 – COL. 5, line 17) that return data is independently transmitted from a TV signal (see page 7 of the Final Action). It is respectfully submitted that the Examiner’s reliance on Lancelot is misplaced.

To begin, Lancelot discloses in FIG. 2 a primary station (105) which is a shared (trunked) device in a central location that provides services to many subscribers and users. The primary station (105) sends data to a plurality of secondary stations (110) that are located within the users’ homes (including telephones, PCs, video displays, etc.) via a HFC (hybrid fiber coaxial) communications system (103). Lancelot discloses that a TV signal is transmitted with other signals (via combiner (104)) on the HFC communications system (103), and that CACS (cable access signaling) is used for transmission and reception of data, etc. over communication channel (103) at radio frequencies compatible with cable television CATV networks (see, Col. 4, lines 45-66, and Col. 5, lines 45-55).

In this regard, Lancelot is yet another example of using communications over low bandwidth cable networks, which the inventors distinguish from the claimed inventions (see, e.g., pages 1 and 2 of Applicants’ specification. In this regard, the relevance of Lancelot is questionable at best with respect to the claimed inventions.

Moreover, the Examiner has not demonstrated proper motivation for combining Krisbergh and Lancelot. The Examiner contends that it would have been obvious to modify Krisbergh to Lancelot. Although not clear, it appears that Examiner contends that it would have been obvious to modify Krisbergh with Lancelot’s purported teaching of independently transmitting a data signal downstream independent of a TV signal.

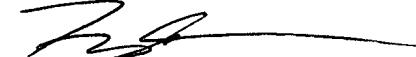
However, it is axiomatic that if a proposed modification would render a prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See, MPEP 2143.01, citing *In re Gordon*, 733

F.2d 900 (Fed. Cir. 1964). Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See, MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Here, Krisbergh discloses a method of transmitting data to a terminal by inserting the data signal in a VBI of the TV video signal for purposes of displaying the data on a display device associated with the terminal. This is the basis of the Krisbergh protocol and Krisbergh cites advantages to such downstream data transmission (see, e.g., Col. 8, lines 1-34). Examiner's proposed modification of Krisbergh (not including data in the VBI of the TV signal) would fundamentally change the principle and purpose of the Krisbergh system, which renders the obviousness rejections deficient on their face.

Applicants respectfully submit that claim 36 is patentable and non-obvious over the combination of Krisbergh, Lancelot and Yasuki for reasons similar to that given above for claim 1. Indeed, Yasuki does not cure the deficiencies of Krisbergh and Lancelot. Accordingly, for at least the above reasons, claims 1 and 36 (and all claims that depend therefrom) are patentable over the cited art of record.

Respectfully submitted,



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